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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,673	01/29/2004	George Hadley Callaway	9417.17685-DIV	5417

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EXAMINER

MILLER, CHERYL L

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/767,673

Applicant(s)

CALLAWAY ET AL.

Examiner

Cheryl Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

It is noted to the applicant, that in claim 2, the claim requires the mount to move relative the support and additionally recites, "a first member carried by the mount and *permitting relative movement of the first member and the mount*". This portion of the claim is being interpreted by the examiner to mean the first member and the mount together move relative the support. If the applicant intended to claim relative movement *between* the first member and the mount, it is suggested to use language such as "permitting relative movement between the first member and the mount". The same issue occurs within the claim when referring to the second and third members. For the current rejection below, the claim has been interpreted to only require relative movement between the mount and the support.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and; *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 2-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,736,852. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims are merely broader than the patented claims. If an applicant has a patent on the narrower claims, he/she is not entitled to a patent on the broader claims. *In re Goodman*.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Alby (US 6,241,730 B1, cited by applicant in IDS). Alby discloses an assembly (see fig.1 or 4) comprising a prosthesis (10 may be considered a prosthesis), a support (4B/4Ba) having a supporting surface (outer surface of 4Ba), a mount (8) including a mounting surface (8a+8b), the mount (8) adapted to permit movement relative to the supporting surface (4Ba; see fig.1), a series of sequentially stacked members (12, 12, 11 in fig.1; or 12, 12, 12 in fig.4) including a first member (12) carried by the mount, a second member (12) stacked above the first member, and a third member (11) stacked above the second member, and a locking mechanism (lock 9 screws in) adapted to compress the members in a first mode (when screwed tight) and in a second mode (when unscrewed) to allow movement of the mount (8) on the support surface (4Ba).

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Alby discloses one member (11) adapted to move in concert with the supporting surface (4Ba) and not the mount (8), and another member (12) adapted to move in concert with the mount (8) and not the supporting surface (4Ba). Alby discloses one member (12) having a marginal edge *adapted to engage* (although a clearance is present when aligned, when angled, the edge is adapted to engage the mount edge) an interior margin of the mount (8a) and move with the mount (8) and not the supporting surface (4Ba). Alby discloses one member (11) having a marginal edge *adapted to be free* (a clearance is shown when aligned) from the interior margin of the mount (8a), which moves in concert with the supporting surface (4Ba) and not the mount (8).

Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Harris (US 6,248,132 B1, cited by applicant in IDS). Harris discloses an assembly comprising a prosthesis (10, 12), a support (16) having a supporting surface (18), a mount (92) including a mounting surface (outer surface), the mount (92) adapted to permit movement relative to the supporting surface (18), a series of sequentially stacked members (fig. 8, 9, 6) including a first member (104) carried by the mount, a second member (100) stacked above the first member, and a third member (90) stacked above the second member, and a locking mechanism (threads between 90 and 92) adapted to compress the members in a first mode and in a second mode to allow movement of the mount on the support surface.

Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Stone et al. (US 6,387,130 B1). See for example, figure 4B. Stone discloses an assembly comprising a

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prosthesis (30 may be considered a prosthesis), a support (20A) having a supporting surface (edge abutting 20B), a mount (20B) including a mounting surface, the mount (20B) adapted to permit movement relative to the supporting surface (20A), a series of sequentially stacked members including a first member (20C) carried by the mount, a second member (20D) stacked above the first member, and a third member (20E) stacked above the second member, and a locking mechanism (knot, 31) adapted to compress the members in a first mode and in a second mode to allow movement of the mount on the support surface.

Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Keynan (US 6,755,862 B2). Keynan discloses an assembly comprising a prosthesis (400), a support (260) having a supporting surface (bottom surface in fig.12b), a mount (250 adjacent 260) including a mounting surface (top surface in fig.12b), the mount adapted to permit movement relative to the supporting surface (fig.12a, 12b), a series of sequentially stacked members including a first member (member 250 distal mount in fig.12b) carried by the mount, a second member (member 250 distal first member in fig.12b) stacked above the first member, and a third member (member 250 stacked distal the second member in fig.12b) stacked above the second member, and a locking mechanism (polymer, wire, etc. col.4, lines 40-67) adapted to compress the members in a first mode and in a second mode to allow movement of the mount on the support surface.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (571) 272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cheryl Miller



BRUCE SNOW
PRIMARY EXAMINER